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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,012	01/10/2001	Michael J. Munson	65714-8	8112

22504 7590 07/05/2006

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EXAMINER

COLBERT, ELLA

ART UNIT PAPER NUMBER

3693

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/758,012	Applicant(s) MUNSON, MICHAEL J.	
	Examiner Ella Colbert	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16 and 18-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16 and 18-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 16 and 18-36 are pending in this communication filed 12/22/05 entered as Response to Election/Restriction.
2. The Response After Non-Final Action (Miscellaneous communication to Applicant) filed 04/07/06 has been entered.
3. The Correspondence Address Change filed 4/11/06 has been entered.
4. The Preliminary Amendment filed 12/30/05 has been entered.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 16 and 18-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16, on page 4, lines 1-5, recites "... browser display...; said customized sponsorship tool display including said data concerning ...; and ... tool display to said".

The "display" is very vague and unclear. The claim language does not recite what the "browser" is being displayed on or what the "tool" is being displayed on. The claim is also not in proper format for a method claim. The claim should begin after "... browser display ...; customizing a sponsorship tool displayed on a display screen including said data concerning". Claims 18-23 and 25-28 have a similar problem.

Claim 22 does not recite where the results of the search query is stored.

Claim 23 is rejected based on the 35 USC 112 second paragraph rejection of the base claim.

Claims 34-36 do not have enough steps to be independent claims. Claims 34-36 are similar to dependent claims format.

Correction is required.

Claim Rejections - 35 USC § 101

7. Claims 30-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 30-32 reciting a database per se, is nonfunctional descriptive material either with or without a medium.

Claims 33, 35, and 36 do not have a practical application per se.

Claim 34 is nonstatutory because the claim limitation claims software per se.

As interpreted by the Federal Courts, 35 USC 101 has two purposes. First, 35 USC 101 defines which categories of inventions are eligible for patent protection. An invention that is not a machine, and article of manufacture, a composition, or process cannot be patented. See *Diamond v. Chakrabarty*, 447 US 303, 206 USPQ (1980); *Diamond v. Diehr*, 450 US 175, 209 USPQ 1 (1981). Second, 35 USC 101 serves to ensure that patents are granted on only those inventions that are “useful”. This second purpose has a Constitutional footing – Article I, Section 8 of the Constitution authorizes Congress to provide exclusive rights to inventors to promote the “useful arts”. See *Carl Zeiss Stiftung v. Renishaw PLC*, 945 F.2d 1173, 20 USPQ2d 1094 (Fed. Cir. 1991). Thus, to satisfy the requirements of 35 USC 101, and applicant must claim an invention that is statutory subject matter and must show that the claimed invention is “useful” for

some purpose either explicitly or implicitly. Application of this latter element of 35 U.S.C. 101 is the focus of these guidelines.

To satisfy 35 USC 101, an invention must be “useful”. Courts have recognized that the term “useful” used with reference to the utility requirement can be a difficult term to define. Brenner v. Manson, 383 U.S. 519, 529, 148 USPQ 689, 693 (1966) (simple everyday word like “ useful” can be “pregnant with ambiguity when applied to the facts of life.”).

Correction in the claim limitations is required to overcome the 35 USC 101 rejection in order for the claims to have a proper examination.

Inquiries

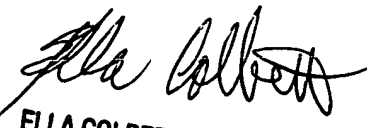
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Tuesday-Thursday, 6:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

June 24, 2006


ELLA COLBERT
PRIMARY EXAMINER